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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,069	03/02/2004	Christopher R. Carlson	031890-1754	2799
27433	7590	09/09/2004	EXAMINER	
FOLEY & LARDNER 321 NORTH CLARK STREET SUITE 2800 CHICAGO, IL 60610-4764			GONZALEZ, MADELINE	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/791,069	Applicant(s) CARLSON ET AL.	
	Examiner Madeline Gonzalez	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-40 and 44-48 is/are rejected.
- 7) ☒ Claim(s) 41-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed on March 15, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The US references have been considered; however the non-patent literature cited on page 2 of the information disclosure statement has not been considered since applicant failed to provide copies.

Claim Objections

2. Claim 38 is objected to because of the following informalities:
- a) Claim 38: The claim recites the limitation "the storage compartment" in lines 3-4.
- There is insufficient antecedent basis for this limitations in the claim.

Appropriate correction is required.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claim 40 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 27 of prior U.S. Patent No. 6,722,051. This is a double patenting rejection.

U.S. Patent No. 6,722,051 discloses a device for rendering shapes upon a material, the device comprising:

- a) a frame having a substantially flat lower surface, the flat lower surface sized to support the device in an upright position;
- b) a marking device adjustment assembly coupled to the frame and including an adjusting knob, a plunger, and a biasing member in contact with both the adjusting

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knob and the plunger, the adjusting knob applying pressure directly against the biasing member; and

- c) a marking device assembly at least partially enclosed by the frame and operatively coupled to the marking device adjustment assembly, the frame having a storage compartment for storing at least additional marking device assembly wherein the marking device adjustment assembly includes a marking device operating mode indicator, the position of the operating mode indicator affecting the approximate amount of pressure applied to the marking device assembly during operation.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 29-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,722,051. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,722,051 discloses a shape cutting system for cutting a material having a surface, the system comprising:

- a) a frame having a lower support surface;
- b) a blade adjustment assembly coupled to the frame;
- c) a blade assembly connected to the frame, the blade assembly positioned at least partially within the frame such that a longitudinal axis of the blade assembly is substantially perpendicular to the lower support surface of the frame, the blade assembly including a blade retainer and a blade operatively connected to the retainer, the retainer having a rigid collar, and the blade assembly rotatable about the longitudinal axis, and
- d) a blade adjustment assembly coupled to the frame and to the blade assembly, the blade adjustment assembly including an adjusting knob, a plunger, and a biasing member in contact with both the adjusting knob and the plunger, the adjusting knob applying pressure directly against the biasing member to adjust the pressure exerted against the blade assembly

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- e) a cutting mat, the cutting mat configured for placement under the material to be cut and the cutting unit;
- f) wherein the cutting unit includes a protective cover covering the lower surface of the frame and the lower portion of the blade assembly;
- g) wherein the frame includes a base and a housing coupled to the base, wherein the housing is configured to enclose at least a portion of the blade adjustment assembly and the blade assembly, wherein the blade assembly extends along a first axis, and wherein the lower surface of the base defines a plane which is substantially perpendicular to the first axis; and
- h) wherein the blade assembly is rotatable about the first axis in at least one of a clockwise and a counterclockwise direction.

7. Claims 34-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-10 of U.S. Patent No. 6,722,051. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,722,051 discloses a shape cutting system for cutting a material having a surface, the system comprising:

- a) a frame having a lower support surface;
- b) a blade assembly coupled to the frame, the blade assembly positioned at least partially within the frame such that a longitudinal axis of the blade assembly is substantially perpendicular to the lower support surface of the frame, the blade assembly including

- a blade retainer and a blade connected to the retainer, and the blade assembly rotatable about the longitudinal axis; and
- c) a blade adjustment assembly coupled to the frame and including a blade operating mode indicator, the position of the operating mode indicator affecting the approximate amount of downward pressure applied to the blade during operation, the blade adjustment assembly also including an adjusting knob, a plunger, and a biasing member in contact with both the adjusting knob and the plunger, the adjusting knob applying pressure directly against the biasing member to adjust the pressure exerted against the blade assembly;
- d) wherein the blade operating mode indicator indicates which of at least a first and a second operating mode the device is operating in; and
- e) wherein the first operating mode is a free-form cutting mode and wherein the second operating mode is a template cutting mode.

8. Claims 37-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-23 of U.S. Patent No. 6,722,051. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,722,051 discloses a device for rendering shapes upon a material, the device comprising:

- a) a frame having a substantially flat lower surface sized to support the device in an upright position;

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- b) a marking device adjustment assembly coupled to the frame and including an adjusting knob, a plunger, and a biasing member in contact with both the adjusting knob and the plunger, the adjusting knob applying pressure directly against the biasing member;
- c) a marking device assembly at least partially enclosed by the frame and operatively coupled to the marking device adjustment assembly, the marking device assembly including a marking portion having a longitudinal axis substantially perpendicular to the flat lower surface of the frame and passing through the center of the device;
- d) wherein the frame further includes a base having the substantially lower surface, a housing at least partially enclosing the marking device assembly, and an arm connecting the base to the housing, and wherein the arm has a storage compartment; and
- e) a protective cover removably operatively connected to the frame and covering at least a portion of the marking device assembly.

9. Claim 44 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of U.S. Patent No. 6,722,051. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,722,051 discloses a device for rendering shapes upon a material, the device comprising:

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- a) a frame having a substantially flat lower surface, the flat lower surface sized to support the device in an upright position;
- b) a marking device adjustment assembly coupled to the frame and including an adjusting knob, a plunger, and a biasing member in contact with both the adjusting knob and the plunger, the adjusting knob applying pressure directly against the biasing member;
- c) a marking device assembly at least partially enclosed by the frame and operatively coupled to the marking device adjustment assembly, wherein the marking device adjustment assembly is adjustably positionable in a plurality of positions and wherein each position of the marking device adjustment assembly results a different amount of downward pressure applied to the marking device assembly.

10. Claim 45 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of U.S. Patent No. U.S. Patent No. 6,722,051 in view of Morozumi (U.S. 4,934,054).

U.S. Patent No. 6,722,051 discloses all the subject matter claimed above in paragraph 9 with the exception of the specific types of blades.

With respect to the specific types of blades: Morozumi discloses a device having a marking device assembly, wherein the marking device assembly is a blade assembly, as shown in

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Fig. 6, and said blade assembly includes single edged blade. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the device disclosed by U.S. Patent No. 6,722,051 with a single edged blade as the marking device, as taught by Morozumi, in order to accurately cut an object.

11. Claims 46 and 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of U.S. Patent No. 6,722,051 in view of Nelson (U.S. 6,112,425).

U.S. Patent No. 6,722,051 discloses all the subject matter claimed above in paragraph 9 with the exception of a template and the specific material of the template.

With respect to the template: Nelson discloses a template 10 for guiding a writing or cutting implement, as shown in Fig. 1, having a substantially flat sheet having first and second sides, a periphery and at least one opening extending from the first side to the second side, the first side of the sheet configured for placement upon a material to be cut, the second side of the sheet configured to contact the writing or cutting implement, the first side laterally extending at the periphery and at the at least one opening farther than the second side to define a chamfer at the periphery and at the at least one opening of the template 10. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the template disclosed by Nelson with the device disclosed by U.S. Patent No. 6,722,051 in order to

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mark the different shapes provided in the template since Nelson suggests that the template is used to guide a writing or cutting device.

With respect to the specific material of the sheet: U.S. Patent No. 6,722,051 as modified by Nelson disclosed a template having a flat sheet, said sheet being made of some material. The specific material claimed by applicant, i.e., the sheet made of a semi-transparent tinted template material, absent any criticality, is only considered to be the “optimum” material of the sheet disclosed by Nelson that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy, manufacturing costs, etc. See In re Boesch, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the template of a semi-transparent material in order to be able to see through the template and cut the shapes more precisely.

12. Claim 48 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of U.S. Patent No. 6,722,051 in view of Snyder (U.S. 3,456,346).

U.S. Patent No. 6,722,051 discloses all the subject matter claimed above in paragraph 9 with the exception of a protective cover.

With respect to the protective cover: Snyder discloses a circle cutter, as shown in Fig. 1, having a protective cover 40 removably connected to a base of a body portion 10 and covering a lower surface, as shown in Fig. 3. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a protective cover as taught by Snyder to the device disclose by U.S. Patent No. 6,722,051 in order to protect the marking device when the device is not in use.

Allowable Subject Matter

13. Claims 41-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nelson discloses a spring-loaded engraving tool holder. Mocerri discloses a cutting apparatus. Lira-Nuñez et al. ('068) and ('577) disclose related guided cutting systems.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243.

The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG



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